



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,826	04/06/2006	Gerard Marx	2488.014	8215

23405	7590	07/09/2008
HESLIN ROTHENBERG FARLEY & MESITI PC		
5 COLUMBIA CIRCLE		
ALBANY, NY 12203		

EXAMINER	
AUDET, MAURY A	

ART UNIT	PAPER NUMBER
1654	

NOTIFICATION DATE	DELIVERY MODE
07/09/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

10/533,826

Applicant(s)

MARX ET AL.

Examiner

MAURY AUDET

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/10/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7-10, 11-14, 20-25, 31-41, 43, and new claims 48-51 is/are pending in the application.
- 4a) Of the above claim(s) 11-14, 20-25, 31-33, 37-41, 43, and new claims 50-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-10, 34-36 and new claims 48-49 is/are rejected.
- 7) ☒ Claim(s) 1, 7-10, 34-36 and new claims 48-49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/21/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 1654

DETAILED ACTION

The present application has been transferred from former Examiner Young to the present Examiner.

Applicant's amendment and response is acknowledged.

Election/Restrictions

As previously noted, Applicant's **election without traverse of Group I, original claims 1-10 and 34-36, as drawn to the elected peptide of the invention, a peptide consisting of SEQ ID NO: 1** in the reply filed on 7/10/07 is acknowledged.

Amended claims 11-14, 20-25, 31-41, 43, and new claims 50-51 are now withdrawn from consideration. **Claims 1, 7-10, 34-36 and new claims 48-49 have only been examined in so far as they read upon the elected peptide of the invention, a peptide consisting of SEQ ID NO: 1.**

In response hereto, Applicant is asked to put the claims with their proper status identifier.

Claim Objections

Claims 1, 7-10, 34-36 and new claims 48-49 have only been examined in so far as they read upon the elected peptide of the invention, a peptide consisting of SEQ ID NO: 1 are objected to because of the following informalities: the claims have not been amended commensurate in scope with their elected invention.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Applicant's arguments are noted, however, until the present claims are amended commensurate in scope with the elected invention, as discussed above, the arguments are deemed moot, as the breadth of subject matter still claimed arguably reads upon or is read upon by the double patenting applications/patents cited below.

The rejections are repeated below for continuity of record:

Claims 1-10 and 34-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,122,620 (09/847,790). Although the conflicting claims are not identical, they are not patentably distinct

Art Unit: 1654

from each other because the '620 patent is drawn to a peptide or any type of composition comprising identical SEQ ID NO: 1. Although the present application is to a "liposomal" compositions comprising SEQ ID NO: 1, compositions comprising liposomes need no reference for an introduction. The use of liposomes to carry e.g. other active agents, in combination with peptides has been well known in the art for over a decade a routinely used form of compositions. Absent evidence to the contrary the these specific liposomes carry some other unexpected property not routinely used within the peptide composition arts.

Claims 1-10 and 34-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-20 of copending Application No. US 20070009571 (11/490,033). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '571 claims 11-20 are drawn to compositions/products comprising SEQ ID NO: 1, identical to presently elected SEQ ID NO: 1, and elected products thereof. Although the present application is to a "liposomal" compositions comprising SEQ ID NO: 1, compositions comprising liposomes need no reference for an introduction. The use of liposomes to carry e.g. other active agents, in combination with peptides has been well known in the art for over a decade a routinely used form of compositions. Absent evidence to the contrary the these specific liposomes carry some other unexpected property not routinely used within the peptide composition arts.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1654

Claims 1-10 and 34-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 11/601,024 (US 20070066535). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '024 claims 1-2 are drawn to a peptide/product comprising a peptide of at least 50-70% identity to the carboxy termini of fibrinogen. Read in light of the specification, SEQ ID NO: 14 meets the limitations of 1-2 of '024 and SEQ ID NO: 14 is identical to presently elected SEQ ID NO: 1, and elected products thereof. Although the present application is to a "liposomal" compositions comprising SEQ ID NO: 1, compositions comprising liposomes need no reference for an introduction. The use of liposomes to carry e.g. other active agents, in combination with peptides has been well known in the art for over a decade a routinely used form of compositions. Absent evidence to the contrary the these specific liposomes carry some other unexpected property not routinely used within the peptide composition arts.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Citation of Pertinent Art Not Relied Upon

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Regarding the subject matter of haptotactic peptides, Applicant has one other issued patent, related, though drawn to distinct haptotactic peptides (all under examination by Examiners other than the present):

US 7,148,190 (10/181,187)

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAURY AUDET whose telephone number is (571)272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1654

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 6/23/2008

/Andrew D Kosar/
Primary Examiner, Art Unit 1654